

PATENT COOPERATION TREATY

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INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 58012WO004	FOR FURTHER ACTION See Form PCT/IPEA/416	
International application No. PCT/US2004/038976	International filing date (day/month/year) 19.11.2004	Priority date (day/month/year) 21.11.2003
International Patent Classification (IPC) or national classification and IPC C09J7/02		
Applicant 3M INNOVATIVE PROPERTIES COMPANY et al.		
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 6 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input checked="" type="checkbox"/> sent to the applicant and to the International Bureau a total of 6 sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input checked="" type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>		
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the opinion</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>		
Date of submission of the demand 16.09.2005	Date of completion of this report 05.12.2005	
Name and mailing address of the international preliminary examining authority:  European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016		Authorized Officer Girard, S Telephone No. +31 70 340-4187 

**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/US2004/038976

Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):*

Description, Pages

1-26 as originally filed

Claims, Numbers

1-32 filed with telefax on 16.09.2005

Drawings, Sheets

1/2, 2/2 as originally filed

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing (*specify*):
 - ☐ any table(s) related to sequence listing (*specify*):
4. ☒ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages
 - ☒ the claims, Nos. 14
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing (*specify*):
 - ☐ any table(s) related to sequence listing (*specify*):

* If item 4 applies, some or all of these sheets may be marked "superseded."

**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/US2004/038976

Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	-
	No: Claims	1-32
Inventive step (IS)	Yes: Claims	-
	No: Claims	1-32
Industrial applicability (IA)	Yes: Claims	1-32
	No: Claims	-

2. Citations and explanations (Rule 70.7):

see separate sheet

Re Item V

**Reasoned statement with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement**

1. Art.34(2)(b) PCT

The amendments filed with the fax dated 16.09.2005 do introduce subject-matter which extends beyond the content of the application as filed, contrary to Article 34(2)(b) PCT. The amendment concerned is the following:

1.1: "The release liner according to any one of claims 1 to 13 in combination with a pressure sensitive adhesive so to form an assembly, wherein fluid egress channels are formed in a bonding surface of the pressure sensitive adhesive, by the pattern formed in said paper, that define exit pathways for fluid to bleed out from behind said article when said structured bonding surface is disposed on a substrate" (claim 14). Clearly, the article has not been defined yet, but will appear for the first time in claim 15; therefore, the subject-matter of claim 14 is neither supported (Art.34(2)(b) PCT), nor clear (Art.6 PCT).

1.2: Furthermore, it is questionable whether support could be found at all in the Application as filed for a claim 14 whereby the reference to the article would be corrected (Art.34(2) (b) PCT).

1.3: In view of the comments here above and of the Applicant's interests, the present International Preliminary Report on Patentability is thus based on claims 1-13 and 15-32, as filed with the telefax dated 16.09.2005.

2. Independent claims 1,21 and 28

2.1: The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of independent claims 1,21 and 28 is not new in the sense of Article 33(2) PCT.

The document D1 discloses (the references in parentheses applying to this document):

an adhesive-backed article, comprising: (a) a film having an upper surface and a lower surface; (b) a pressure sensitive adhesive having a first surface and second surface, said first surface bonded to the lower surface of said film; and (c) a release liner bonded to the second surface of said pressure sensitive adhesive, said release liner having a micro structured surface that defines a micro structured surface in the second surface of said pressure sensitive adhesive, the micro structured surface in said adhesive forming channels that define a volume of at least $1 \times 10^3 \cdot \mu\text{m}^3$ per any $500 \mu\text{m}$ diameter circular area of said adhesive, the channels define exit pathways that provide a fluid egress to a periphery of said article when said release liner is removed and said article is applied to a substrate, said adhesive-backed article being sealable as indicated by a result of at least 85% according to the percent wet out test, and the channels being substantially undetectable on the upper surface of said compliant film, after removal of the release liner and final application of said article onto the substrate (**claims 1-18; page 2, line 13-page 3, line 19; page 9, line 25-page 11, line 25; page 13, lines 12-26; examples 1-11; table 1**).

Especially on **page 13, lines 14 to 19**, D1 describes release liners which are made of a paper coated with a polymeric film, which may additionally be siliconized or treated in order to impart improved release characteristics; i.e., D1 teaches that these coated papers already exhibit release properties, and thus correspond to what is disclosed in claim 1 as "a piece of paper (...) and a release material bonded" thereto. The distinction made by the applicant between the release material and the paper support is artificial, and the mere fact that a document does not use the same formal distinction, does not mean that the laminated structure describes therein does not contain all the essential technical features of claim 1.

2.2: The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 1 is not new in the sense of Article 33(2) PCT.

Document D2 discloses (the references in parentheses applying to this document): a release liner comprising a release coating attached to a structured surface of a paper layer, whereby the structured surface includes an array of pyramidal depressions capable of providing fluid egress when attached to a layer of adhesive resin (**claims 1,11-14; page 6, lines 12-32; page 7, lines 25-31**). Following a reasoning similar to the

one of point 2.1 here above, the release liners of D2 anticipate the one disclosed in claim 1.

2.3: The Applicant's attention is drawn to the fact that documents D3 and D4 are equally detrimental to the novelty of independent claims 1,21 and 28 (Article 33(2) PCT).

3. Dependent claims 2-13,15-20,22-27,29-32

3.1: Dependent claims 2-13,15-20,22-27 and 29-32 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step (Article 33(2) and (3) PCT).

4. Further comments

4.1: Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in the documents D2, D3 and D4 is not mentioned in the description, nor are these documents identified therein.

4.2: The expression "herein incorporated by reference" and similar expressions, used on pages 4 and 19, should be deleted; Rule 9.1(iv) PCT.